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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/029,579 05/06/98 LANDEGREN

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EXAMINER

GANSHEROFF, L

ART UNIT

PAPER NUMBER

1636

DATE MAILED:

08/16/01

24

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/029,579

Applicant(s)

LANDEGREN, ULF

Examiner

Lisa J. Gansheroff

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 June 2001* FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 08 June 2001*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see below.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-7.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation:


*Upon a telephone inquiry by the Examiner August 2001 regarding the apparent lack of a response to the previous Office Action, Applicants on August 07, 2001 faxed copies of documents including Amendment, Declaration under 37 CFR 1.132, a new Declaration (for Patent Application), a Sequence Listing, a Power of Attorney, a Notice of Appeal and extension of time, a copy of a check, and a copy of a receipt stamped by OIPE June 08 2001 indicating receipt of these documents. Thus, although the original copies of these documents had not been matched with the file, the faxed copies were entered into the file and considered by the Examiner.

Claims 1-6 stand rejected under 35 USC 112, first paragraph, for the reasons made of record in the Office Action of 05 December 2000. Although Applicant intended to cancel these claims, the After-Final amendment could not be entered because of new considerations as discussed below.

Claim 7 stands rejected under 35 USC 102(b) for the reasons made of record previously in the Office Action of 05 December 2000. In response to this rejection, Applicant states the following: that the instant application is entitled to a priority date of September 8, 1995; that Nilsson et al. was published Sept. 30, 1994, less than one year before the priority date and thus the rejection should be under 35 USC 102(a); and that the Katz Declaration under 37 CFR 1.132 (filed with the amendment) states that the instant inventor Landegren is a co-author on Nilsson et al. and that the other co-authors on Nilsson et al. did not contribute to the concepts presented. In response to this, the Examiner notes that the priority date of September 8, 1995 is from a foreign priority document (Sweden). The effective filing date in the United States of the instant application is the filing date of the PCT application, which is September 06, 1996. Since the publication date of the Nilsson et al. reference is more than one year prior to September 06, 1996, this reference was properly applied under 35 USC 102(b). Thus, the rejection stands.

Newly-submitted claims 8-12 present new considerations because they lack the limitation regarding a "pharmaceutical composition" presented in original claims 1-6 although they have other limitations present claims 1-6 (as noted also in Applicant's Remarks), and claims 8-12 have limitations that are not in claim 7. As newly-submitted claim 11, for example, contains a limitation not taught in Nilsson et al., a rejection under 35 USC 103(a) would need to be considered, and the types of chemically reactive compounds encompassed by the claim (but not listed in the claim or specification) would also need to be considered. Since the claim originally containing this limitation (5) also included the limitation of a pharmaceutical composition, and since it would not have been proper to have made both an enablement rejection and an obviousness rejection for the same claim in the previous Office Action, the consideration of a rejection under 35 USC 103(a) at this point would be a new consideration after the Final rejection. (The limitations in claims 8, 9, 10, and 12 are taught in Nilsson et al.) Thus, the amendment to the claims, which adds new claims 8-12 (and cancels claims 1-6) was not entered.

Applicant also amended the specification; the amendments to the specification were entered since they relate only to formal matters: the inclusion of a Sequence Listing and a SEQ ID NO identifier. The computer readable form of the Sequence Listing has been entered into the database.



JAMES KETTER
PRIMARY EXAMINER